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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,303	06/03/2002	Marc Saelen	10541-927	8786

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EXAMINER	
COMPTON, ERIC B	

ART UNIT	PAPER NUMBER
3726	

DATE MAILED: 05/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/030,303	SAELEN ET AL.	
	Examiner	Art Unit	
	Eric B. Compton	3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 February 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *18-43* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *18-43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 22, 2005, has been entered.

Claim Objections

2. Claim 18 is objected to because of the following informalities: in line 16, there should be a –the—before "pivotable member." Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 18-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 18 recites the limitation "the first to the second configuration" in last line of the claims. There is insufficient antecedent basis for this limitation in the claim.

Claims 24-25 also reference the second configuration. Claims 19-30 depend from claim 18 and therefore are also indefinite.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 11-26, 29-39 and 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. 4,243,456 to Cesano in further view of U.S. Pat. 4,991,478 to Riley.

Cesano discloses a process (and a device process) for forming a planiform piece intended for an interior fitting of a motor vehicle (see Figure 6), the process comprising:

covering at least one layer of at least one face along a portion (in vicinity of 143) of a support material (10) with a cladding (11);

cutting (with blade 141) along said portion such that said cladding (11) projects from said support material (10) in said portion;

pre-positioning a cutting tool (151) between said cladding (11) and said support material (10) along said portion; and

cutting along said portion with said cutting tool (151) when said support material (10) is covered with said cladding (11), simultaneously while forming a laminate.

Cesano discloses the invention cited above consistent with that of the embodiment of Applicant shown in Figure 3. However, Cesano does not disclose the position the cutting tool between the cladding and the support material by providing

mounting the cutting tool on a pivotable member mounted on at least one of the die and punch.

Riley discloses a process (and a device) for forming a planiform piece for an interior fitting of a motor vehicle (see Figure 1). Riley wishes to trim the edge of the planiform to remove a portion a support material (22) while covered with a covering material (26). *See* Col. 3, lines 45-55; Col. 5, lines 3-8.

> Blade fixture 60 holds the blades in one of two positions, an open workpiece accessing position and a closed, cutting position. The cutting position is shown in FIG. 2. In FIG. 3, the cutting position is shown in solid lines and the open position in dashed lines. Actuator 62 (FIG. 2), which may be hydraulic, pneumatic, mechanical or electromechanical, moves the blade fixture between the two positions. In the open position, the workpiece may be readily inserted for trimming or removed after trimming. In the closed position the blades are oriented generally vertically for cutting. Rollers 58 are seen in FIG. 2 in contact with the blade segments. The rollers are pressed into contact with blade segments 42 by pneumatic or mechanical actuators 64, which apply pressure to the rollers.

See Col. 4, lines 52-66. This embodiment generally corresponds to the embodiments of Applicant shown in Figures 1, 2, and 4. Thus, Riley discloses pivotable member for positioning the cutting tool (42) includes a support (60) for co-operating with at least one of the punch (38) and the die (36). "[R]emoval of the workpiece is effected by first returning the blade assemblies to the open position prior to removal." Col. 7, lines 2-4. A second embodiment of the invention, discloses a translational cutting tool, akin to Cesano and the embodiment of Applicant shown in Figure 3. *See* Figures 6-7.

Regarding claims 18 and 31, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have positioned the cutting tool between the cladding and the support material by providing mounting the cutting tool on

a pivotable member mounted on at least one of the die and punch in the invention of Cesano, in light of the teachings of Riley, since a translational cutting tool and articulated cutting tool are equivalent means. *See In re Ruff*, 256 F.2d 590, 598 (CCPA 1958) (holding prima facie obviousness of equivalence may be suggested by prior art).

Regarding claims 19-21 and 32-34, Riley discloses an intermediate member (66) for rotatably securing the pivotable member (66) to the die. As to the securing the intermediate member to the punch, it has been held that a mere reversal of essential working parts of a device involves only routine skill in the art. *In re Einstein*, 46 F.2d 373 (C.C.P.A. 1931).

Regarding claim 22-23 and 35-36, Riley disclose a jack (62) acting on the cutting tool support (70) for applying a pressure to a cutting portion; and the mold includes an applying means (58) for applying pressure to the cutting portion.

Regarding claims 24-25 and 37-38, Riley discloses providing stops/rollers (58 having cam surfaces) for applying force to, i.e., pressing the pivotable member (70) and cutting tool (42) is provided. The lower actuator (66) acts as a lower stop for the pivotable member (70).

Regarding claims 26 and 39,Riley disclose providing the cutting tool with a non-cutting portion (74, 76) for contacting the cladding sheet and holding the cladding against the die as the die is moved towards the punch. *See* Col. 5, lines 13-21.

Regarding claims 29-30 and 42-43, Riley discloses the use of elastic return means to cause the cutting tool to "spring back into their resting positions after cutting."

See Col. 6, lines 63-65. Cesano also discloses elastic return means (161) which spring back after cutting.

8. Claims 27-28 and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cesano/Riley as applied to the claims above, and further in view of JP 63-199628 to KASAI KOGYO CO.

Cesano and Riley disclose the invention cited above. However, they do not disclose providing a frame attached to the mould for contacting the cladding sheet.

KASAI KOGYO CO discloses a method (and device) similar to that of Cesano and Riley. A frame (20) is provided, which is attached to the mould for contacting the cladding sheet. It appears a jack is also provided for as contemplated by Applicant, for controlling the elevation of the frame. *See* Figures 1-3.

Regarding claims 27-28 and 40-41, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Cesano/Riley with a frame attached to the mould for contacting the cladding sheet, in light of the teachings of KASAI KOGYO CO, in order to pull the cladding sheet taut while cutting.

Response to Arguments

9. Applicant's arguments filed June 15, 2004, have been fully considered but they are not persuasive.

Claim 18 and 31 require a cutting tool mounted for pivotal movement of a pivotable member. According to the Specification, this corresponds to the embodiments

shown only in Figures 1, 2, and 4. Page 7, lines 26-28. The Examiner previously addressed these embodiments in the rejection of claim 12 in the Final Office Action.

In this response, Applicant offers no arguments to refute the previous rejection of claim 12 and its dependent claims.

In Applicant's previous response of June 15, 2004 ("Response"), Applicant argues that

> While Cesano discloses a method for forming a laminate, Cesano does not disclose simultaneously laminating a cladding sheet to a support material and cutting said support material. Cesano discloses first laminating a flexible film to a substrate layer and then through additional and subsequent steps, cutting the substrate layer, as depicted In Figures 1-3. The present invention advantageously provides simultaneous forming and cutting of a support material and cladding sheet in a single operation.
>
> Response, page 10. With respect to Cesano Applicant notes,
>
> Cesano discloses a method for laminating inner door panels for an automobile. An upper and lower mold member are moves towards each other to mold a substrate layer and a coating layer (column 7, lines 15-24). After full compression of a pair of resilient elements and upon further downward movement of a press platen, the threshold value of deformation of the resilient elements will be reached and eventually a cutting edge interacts with a shearing edge to cut off a margin portion to produce a substrate edge while maintaining the free edge portions of the coating layer (Column 7, lines 56-66).

Id. at page 9. Applicant then tries to distinguish the instant invention by indicated that the forming and cutting steps are preformed simultaneously. *Id.*

However, a review of the Specification reveals that Applicant's invention is performed in essentially the same manner as Cesano. "Said punch 11 and said die 12 are movable towards one another to enable the mould to be closed in a so-called 'forming' direction 14." Specification, page 4, lines 18-19. "Said support 1 and said cladding 4 are adhered to one another by closing said mould, in said forming direction

14, said support 1 and said cladding 4 being possibly formed simultaneously, according to the profile given to air gap 13. For this purpose, ***thermocompression is used***." *Id.* at page 4, line 33 to page 5, line 3 (emphasis added). "Cutting and closing of the mould can advantageously by co-ordinated by controlling the path of cutting tool 5 in relation to the relative path of die 12 and of punch 11 in such a way as to complete these two operations simultaneously. In other words, ***said cutting will be carried out at the end of the closing movement*** of mould 10 in said direction 14." *Id.* at page 5, lines 4-8 (emphasis added).

In Cesano, during forming compression of the layers is controlled by gradually increasing the force through resilient members (161, 162) and springs (182, 183) by movement of platen (18). Col. 7, lines 45-47. Once full compression of resilient members (161, 162) and springs (182, 183) is reached the platen (18) contacts the upper mold member (14) and they travel together with cutting element (15) moving downwardly as well. *Id.* at lines 56-66. Thus just like Applicant, the cutting (with the intermediate cutting member between the layers) is performed at the end of closing movement of the mold. According to Applicant is a simultaneous process.

Applicant also argues that Riley does not disclose "simultaneous forming and cutting." Response, page 11. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091,

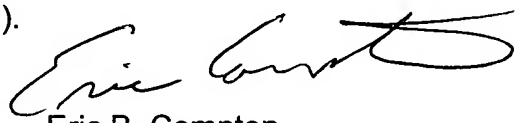
231 USPQ 375 (Fed. Cir. 1986). The Examiner cited Riley for teaching that a translational cutting tool and articulated cutting tool are equivalent means in the art.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Compton whose telephone number is (571) 272-4527. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter D. Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eric B. Compton
Primary Examiner
Art Unit 3726

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